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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,970	11/14/2000	Wayne H. Rothschild	47079-00063	8706

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EXAMINER	
RADA, ALEX P	
ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 04/01/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/711,970	ROTHSCHILD, WAYNE H.	
	Examiner	Art Unit	
	Alex P. Rada	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 January 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11,13-38,40-55,57,59,60 and 62-67* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11,13-38,40-55,57,59,60 and 62-67* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Response to Amendment

In response to the amendment filed January 24, 2003, in which the applicant has provided corrections to the specification, cancels claims 12, 39, 56, 58, and 61, claims 1, 28, 55, 57, 59, 60, 64, 66, and 17 have been amended and claims 1-11, 13-38, 40-55, 57, 59-60, and 62-67 are pending in this office action.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-11, 13-19, 22-38, 40-46, 49-54, 59, 62-63, and 66-67 are rejected under 35 U.S.C. 102(e) as being anticipated by Glasson `600.

3. Glasson discloses a basic game, a processor, a wager amount, a plurality of simulated reels on a visual display, one or more special symbols, and an interplay feature activated by the

processor in response to the special symbol interacting graphically with one or more symbols in the array to portray one of a plurality of randomly selectable actions there between that determines a game outcome and the interplay feature generating a payout upon the game outcome as recited in claims 1, 28, 55, 59, 60, 62-63, and 66-67;

the visual display is a video display as recited in claims 2 and 29;

each of the special symbols is associated with at least one of the other special symbols (frog and landing pad) and all the symbols are special symbols as recited in claims 3-4, and 30-31;

the basic game has one or more themes and each special symbol relates to a t least one of the themes (summary) as recited in claims 5 and 32;

the number of reels depends on the theme of the game as recited in claims 6 and 33; the symbols in the array are arranged in visual association with one or more pay lines, the pay lines including at least on thematic pay line and a scatter pay line as recited in claims 7-8 and 34-35;

the outcome of the interplay feature depends on an input from a player (activation of the game) as recited in claims 10 and 37;

the arrangement and outcome of the interplay are determined at least in part by proximity of the special symbols in the symbol array (figures 2-9) as recited in claims 11 and 38;

the interplay generates a payout depending at least in part on an outcome and the affects initialization or scoring of a subsequent round of the interplay feature, and an action screen shown on the visual display, as recited in claims 13-15 and 40-42;

the symbols in the array are arranged in visual association with one or more pay lines and the interplay feature illustrating the path of a pay line (figure 1) as recited in claims 16 and 43;

the number of reels is adjusted (re-spinning) according to an outcome of the interplay feature as recited in claims 17 and 44;

the payout is determined at least in part by the symbol array before or after the interplay feature as recited in claims 18 and 45; during the interplay feature the processor animates at least on of the symbols as recited in claims 19 and 46;

the special symbol moves from a first position in the symbol array to a second position in the array (figures 2-9) and the second position in the array is occupied by another special symbol (landing pad) as recited in claim 22-23 and 49-50;

the special symbol moves to a plurality of positions in the symbol array during the interplay feature (figures 2-9) and wherein at least one of the reels stops rotating after the processor stops as recited in claims 24-25 and 51-52;

during the interplay the special symbol interacts with graphics on the display other than the symbols on the reels (jumping) as recited in claims 26 and 53; and

the action screen in superimposed over the symbols in the array as recited in claims 27 and 54.

4. Claims 57, 59, 60, and 64 are rejected under 35 U.S.C. 102(e) as being anticipated by Bally Gaming (Gooaal!).

5. Bally Gaming discloses a basic game controlled by a processor in response to a wager amount, the basic game including a plurality of symbols randomly places in a symbol array, the plurality of symbols including a plurality of special symbols and an interplay feature activated by the processor in response to a pair of special symbols appearing in the array, the different pairs of the special symbols interacting graphically with each other to portray different actions that

determine a game outcome the actions being randomly selected from a plurality of selectable actions the interplay feature generating a payout based upon the game outcome.

6. Claims 1, 28, 55, 62, 63, 66, and 67 are rejected under 35 U.S.C. 102(e) as being anticipated by Jaffe '432.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Jaffe discloses a basic game, a processor, a wager amount, a plurality of simulated reels on a visual display, one or more special symbols, and an interplay feature activated by the processor in response to the special symbol interacting graphically with one or more symbols in the array to portray one of a plurality of randomly selectable actions there between that determines a game outcome and the interplay feature generating a payout upon the game outcome as recited in claims 1, 28, 55, 62, 63, 66, and 67.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 9, 20-21, 36, 47-48, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glasson `600 in view of Bally Gaming (Gooaal!).

9. Glasson discloses the claimed invention as discussed above except for the theme of the game is selected from a group consisting of football, basketball, baseball, golf, hockey, volleyball, soccer, bowling, archery, people, objects, animals, and vehicles as recited in claims 9 and 36; and the interplay feature simulates a sports event as recited in claims 20 and 47.

Bally Gaming discloses a theme game having an interplay feature simulating a sports event. By having a sports interplay feature as a sports event, one of ordinary skill in the art would be able provide game players with familiar games. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention was made to modify Glasson to include the theme of the game being selected from a group consisting of football, basketball, baseball, golf, hockey, volleyball, soccer, bowling, archery, people, objects, animals, and vehicles and having an interplay feature simulating a sports event as taught Bally Gaming. To do so would attract game players to play a new game.

Regarding claim 21, 48, and 65, the particular indicia used is a matter of design choice, wherein no stated problem is solved, or unexpected result obtained, by using the specific indicia claimed versus the indicia taught by the prior art.

Response to Arguments

10. Applicant's arguments with respect to claims 1-11, 13-38, 40-55, 57, 59-60, and 62-67 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the emphases on the type of actions being portrayed) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Glasson does disclose one of a plurality of randomly selectable actions therebetween that determines a game outcome, the interplay feature generating a payout based upon the game outcome. The frog jumping on the lily pads is one of a plurality of randomly selectable actions that determines a game outcome.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bennett `579 and `482 both disclose a random prize awarding system associated with a gaming console is provide in which the gaming console is arrange to play first game or second game.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 703-308-7135. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

apr
March 25, 2003

S. THOMAS HUGHES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700